

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the comments which follow.

Claims 45-67 were pending in this application, of which claims 47, 58 and 61-67 are withdrawn from consideration. In this response, no claim is amended, canceled, or added. Thus, claims 45-67 remain pending.

Rejections Under 37 C.F.R. § 103

Claims 45-46, 49-50, 52-57 and 60 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Epailard et al. "*Makromolekulare Chemie*, 189(5) (1988), pp. 1035-1042) (hereafter "*Epailard*") on the grounds set forth at pages 3-4 of the Official Action. The rejection is based solely on *Epailard*, which is an article written in French and containing an English abstract. The MPEP provides explicit guidelines on rejections based on abstracts and foreign language documents. Specifically, MPEP § 706.02 provides the following:

Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished).

If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.

In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action.

Under these specific guidelines, it is clear that a non-English document cannot be relied on beyond the English abstract itself, unless an English translation is provided. Further, a rejection based in whole or in part on the abstract only without relying on the full text document is appropriate in limited circumstances for non-final Office Actions. Based on these guidelines, it is understood that a Final Office Action cannot include rejections based in whole, or in part, on the abstract only without relying on the full text document.

For at least this reason, Applicants respectfully request withdrawal of the rejection and the finality of the Office Action. Reconsideration of the application in light of an English translation of the reference is respectfully requested

Further, even if it were proper to reject the claims based fully on the abstract of *Epaillard* in a Final Office Action. The English abstract fails to disclose or render obvious “applying a composition to a three-dimensional substrate”, “curing in a plasma discharge chamber”, or any composition that includes (d) and either (a), (b), (c), a mixture of (a) and (b), or a mixture of (a) and (c) as defined in claim 45. Therefore, no *prima facie* case of obviousness has been established based on the abstract of *Epaillard*.

Furthermore, it appears the Office has improperly relied on the non-English portions of *Epaillard* in rejecting the claims. Specifically, the Office alleges that *Epaillard* uses a catalyst for plasma polymerization described as 2-hydroxy-2-methyl-

1-[4-(1-methylethyl)phenyl]-propanone. However, Applicants have been unable to find such a compound in *Epaillard*. It is not clear where the Examiner located this compound in *Epaillard*. Perhaps it is described in French in a manner that Applicant is not able to understand.

For at least the above reasons, the rejection is improper. Accordingly, Applicants' respectfully request withdrawal of the rejection.

Claims 48, 51 and 59 are rejected under 35 U.S.C. § 103(a) allegedly as being unpatentable over *Epaillard*, as applied to claim 45 above, in view of U.S. Patent Publication No. 2003/0129322 to Kunz et al. (hereafter "*Kunz*") on the grounds set forth at pages 4-5 of the Official Action.

Applicants respectfully traverse this rejection. Claims 48, 51, and 59 each depend on claim 45. As asserted above, *Epaillard* at least fails to disclose or render obvious all of the elements recited in claim 45. Further, *Kunz* appears to be relied upon by the Examiner solely for elements recited in claims 48, 51, and 59, respectively, and *Kunz* fails to remedy at least the deficiencies of *Epaillard* with regard to claim 45. Therefore, for at least this reason the combination of *Epaillard* and *Kunz* fails to render obvious all of the elements recited in claims 45, 51, or 59. Accordingly, Applicants respectfully request withdrawal of the rejection.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the

undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited. Applicants' representative is signing in his capacity under 37 C.F.R. §1.34 on behalf of Applicants. Should a fee be necessary to maintain pendency of the application, including the fee for a Notice of Appeal, the Office is authorized to charge Deposit Account 50-0573, and this paper will serve as a Notice of Appeal.

Respectfully submitted,

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